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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,936	12/16/2003	Todd G. Kirchgessner	DB23 DIV1	6764
23914	7590	03/29/2006	EXAMINER	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			CHERNYSHEV, OLGA N	
			ART UNIT	PAPER NUMBER
			1649	
DATE MAILED: 03/29/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,936

Applicant(s)

KIRCHGESSNER ET AL.

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 6 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 9-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/4; 6/24/5
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group XIX, claim 13 encompassing OATP2 of SEQ ID NO: 2, in the reply filed on February 07, 2006 is acknowledged.

Claims 5-6, 9-12 and 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 07, 2006.

Claim 13, in so far as it is directed to OATP of SEQ ID NO: 2, is under examination in the instant office action.

Sequence compliance

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821 (a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825. Specifically, no sequence identification has been provided for the amino acid sequences presented in Figures 3A-3F of the instant specification. In case these sequences are new, Applicant needs to provide a substitute computer readable form (CRF) copy of a "Sequence Listing" which includes all of the sequences that are present in the instant application and encompassed by these rules, a substitute paper copy of that "Sequence Listing", an amendment directing the entry of that paper copy into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. § 1.821 (e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). The

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instant specification will also need to be amended so that it complies with 37 C.F.R. § 1.821(d) which requires a reference to a particular sequence identifier (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. See M.P.E.P. 2422.04.

Information Disclosure Statement

3. The information disclosure statement filed on June 23, 2004 fails to comply with 37 CFR 1.98(b)(5), which requires the following:

(b)(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

The information disclosure statement filed on June 23, 2004 has been considered in part, specifically, documents 2AR and 2AS have not been considered (See MPEP § 609, specifically III, C(1)).

Claim Objections

4. Claim 13 is objected to for being dependent from a non-elected claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 is directed to a method for identification of a substrate for a part of OATP protein. The claim does not require that the part of OATP polypeptide possesses any particular conserved structure or other disclosed distinguishing feature. Thus, the claim is drawn to a method of using a genus of proteins that is defined only by similarity of structure. However, the instant specification fails to describe the entire genus of proteins, which are encompassed by these claims. In making a determination of whether the application complies with the written description requirement of 35 U.S.C. 112, first paragraph, it is necessary to understand what Applicant has possession of and what Applicant is claiming. From the specification, it is clear that Applicant has possession of a protein, which has the amino acid sequence of SEQ ID NO: 2 identified as OATP2 protein. The utility of the instant OATP of SEQ ID NO: 2 is established as being a liver specific human transporter protein, which defines the utility of the instant claimed method of identifying substrates for OATP of SEQ ID NO: 2. However, the claim, as written, encompasses methods of identifying substrates of parts of OATP. Thus, the claim is not limited to a protein with a specific amino acid sequence. The claim only requires that the proteins used in the instant method would share some degree of structural similarity to the protein of SEQ ID NO: 2. The specification only describes a protein having the amino acid sequence of SEQ ID NO: 2 and fails to teach or describe any other protein which lacks the amino acid sequence of SEQ ID NO: 2 and has the activities possessed by the OATP2 protein of SEQ ID NO: 2.

To provide adequate written description and evidence of possession of a recited genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a recitation of partial structure. There is not even identification of any particular portion of the structure that must be conserved. As stated above, it is not even clear what part of the polypeptide of SEQ ID NO: 2 has the activity of OATP2. The specification does not provide a complete structure of those polypeptides that are parts of a polypeptide of SEQ ID NO: 2 and fails to provide a representative number of species for the claimed genus. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the recited genus.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of proteins, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required.

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See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, the only method for identifying a substrate of OATP2 protein of SEQ ID NO: 2, but not the full breadth of the claim meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 13 is vague and indefinite in so far as it employs the term "OATP" as a limitation. This term is appears to be novel, and without a reference to a precise amino acid sequence identified by a proper SEQ ID NO: one cannot determine the metes and bounds of "OATP". Moreover, because the instant specification does not identify that property or combination of properties which is unique to and, therefore, definitive of a "OATP", an artisan cannot determine

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if a compound which meets all of the other limitations of a claim would then be included or excluded from the claimed subject matter by the presence of this limitation.

10. Claim 13 is also vague and indefinite for recitation "capable of being transported" and "potentially capable of being transported". Applicant is advised that the phrase "potentially capable of" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). It is suggested that recitation "identifying a compound that is transported by OATP" would better reflect the inventive concept of the claimed method, perhaps.

11. Claim 13 is further indefinite as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step that identifies the substrate and the comparison step. One skilled in the art readily appreciates that not every compound that is moved across the membrane can be identified as an OATP2 specific substrate; therefore, it is critical to have a step evaluating the specificity of the transport.

Conclusion

12. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Olga N. Chernyshev, Ph.D.
Primary Examiner
Art Unit 1649

March 20, 2006